

## REMARKS

Upon entry of the foregoing Amendment, claims 1, 3-6, 8-9, 12-24, 26-38, 40-42, 44-45, 48, and 55-56 are pending in the application. Claims 1, 3-6, 12-18, 21-24, 26-38, 42, 44-45, and 48 have been amended. No claims have been cancelled or newly added. Applicants believe that this Amendment does not add new matter. In view of the foregoing Amendment and the following Remarks, allowance of all the pending claims is requested.

### EXAMINER INTERVIEW

Further to the Applicant Initiated Interview Request Form submitted herewith, Applicants hereby request an interview with the Examiner to discuss substantive distinctions between the claimed invention and the references relied upon in the Office Action. As such, Applicant respectfully requests that the Examiner contact Applicant's representative to schedule an interview prior to issuing the next Office Action considering the claim amendments provided above and the arguments provided herein.

### REJECTIONS UNDER 35 U.S.C. § 103

#### A. SUMMARY

The Examiner has rejected claims 1, 3-6, 8-9, 12-24, 26-38, 40-42, 44-45, 48, and 55-56 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent Application Pub. No. 2003/0089765 to Kovlakas ("Kovlakas") in view of various secondary references. In particular, the Examiner has rejected claims 1, 4-6, 8-9, and 12-13 over Kovlakas in view of U.S. Patent No. 7,774,284 to Williams et al. ("Williams"),<sup>1</sup> claim 3 over Kovlakas in view of Williams and U.S. Patent No. 6,233,565 to Lewis et al. ("Lewis"), claim 14 over Kovlakas in view of Williams and U.S. Patent No. 6,005,945 to Whitehouse ("Whitehouse"), claims 15, 17-18, 21-24, 26-27, 29-35, 38, 42, 44-45, 48, and 55-56 over Kovlakas in view of Williams, Whitehouse, and U.S. Patent

---

<sup>1</sup> In numbered paragraph 3, the Examiner has indicated that claim 22 stands rejected over Kovlakas in view of Williams, which appears to be a typographical error because the subsequent discussion does not mention claim 22, and moreover, numbered paragraph 6 and the subsequent discussion identifies and addresses claim 22.

No. 6,527,178 to Gordon et al. ("Gordon"),<sup>2</sup> and claims 16, 19-20, 28, 36-37, and 40-41 over Kovlakas in view of Williams, Whitehouse, Gordon,<sup>3</sup> and Lewis.

**B. PROCEDURAL ERROR : CLAIMS 29-32 AND 44-45**

At the outset, prior to discussing the substantive distinctions between the claimed invention and the references relied upon, Applicants note that the Examiner has committed error that renders the alleged rejection against claims 29-32 and 44-45 legally improper. More particularly, the Examiner has rejected independent claim 28 as allegedly being unpatentable over Kovlakas in view of Williams, Whitehouse, and Gordon *in combination with* Lewis, while rejecting claims 29-32 and 44-45 (which depend from independent claim 28) as allegedly being unpatentable over only Kovlakas, Williams, Whitehouse, and Gordon.

As such, the Examiner has improperly rejected claims 29-32 and 44-45 because the Examiner cited Lewis in the alleged rejection against parent independent claim 28 without citing Lewis in the alleged rejection against claims 29-32 and 44-45 that depend thereon. Accordingly, due at least to the Examiner's error in this respect, the Examiner has committed error in the alleged rejection against claims 29-32 and 44-45, whereby the rejection is improper and must be withdrawn.

**C. CLAIMS 1, 4-6, 8-9, AND 12-13**

As noted in the above summary, the Examiner has rejected claims 1, 4-6, 8-9, and 12-13 under 35 U.S.C. § 103 as allegedly being unpatentable over Kovlakas in view of Williams. This rejection is improper and must be withdrawn for at least the reason that Kovlakas and Williams, either alone or in combination, fail to disclose, teach, or suggest each and every feature recited in the claimed invention.

More particularly, Kovlakas and Williams, either alone or in combination, fail to disclose, teach, or suggest "generating . . . a unique postage indicium in response to receiving a

---

<sup>2</sup> In numbered paragraph 6, the Examiner has omitted claims 34, 42, 44, and 55-56 from the heading, which appears to be a typographical error because the subsequent discussion addresses these claims, and the Examiner has further indicated therein that Gordon corresponds to U.S. Patent No. 6,527,128, which also appears to be a typographical error because previous Office Actions indicate that Gordon corresponds to U.S. Patent No. 6,527,178

<sup>3</sup> See discussion *supra*, note 2 relating to the correct U.S. Patent No. corresponding to Gordon, wherein numbered paragraph 7 has the same typographical error.

request for a postage purchase transaction, wherein the unique postage indicium is logically linked to a unique tracking identifier to track a mail piece delivery status within the United States Postal Service,” “indexing the postage purchase transaction with the unique tracking identifier logically linked to the unique postage indicium in a database [that] associates the indexed postage purchase transaction with the mail piece delivery status associated with the unique tracking identifier logically linked to the unique postage indicium,” and “refunding the postage purchase transaction based on the mail piece delivery status associated with the unique tracking identifier logically linked to the unique postage indicium,” as recited in amended independent claim 1, for example.

Although the Examiner has conceded that Kovlakas does not specifically disclose generating a unique postage indicium that contains or otherwise has a logical relationship to a unique tracking identifier that can track a mail piece delivery status, the Examiner alleges that Kovlakas discloses “generating . . . a unique postage indicium in response to receiving a request for a postage purchase transaction,” storing information associated with the postage purchase transaction in a database, including a unique tracking identifier associated with the postage indicium, and “refunding the postage purchase transaction based on the delivery status associated with the unique tracking identifier.” To support these allegations, the Examiner refers to passages in Kovlakas that describe encrypting and saving information that “uniquely” identifies a mail piece (e.g., a mailer, personal computer meter, and date and time when a postage indicium was produced) and “mailpiece identification data [] used to track whether the mailpiece has been mailed, which [the Examiner] interprets as tracking capability.” As such, the Examiner contends that Kovlakas discloses using the mailer, meter, or other mailpiece identification data “which is part of the unique postage indicium” to search a transaction log for tracking information to determine whether or not a mailpiece has been mailed and contends that Kovalakas “therefore suggest [sic] tracking identifier.”

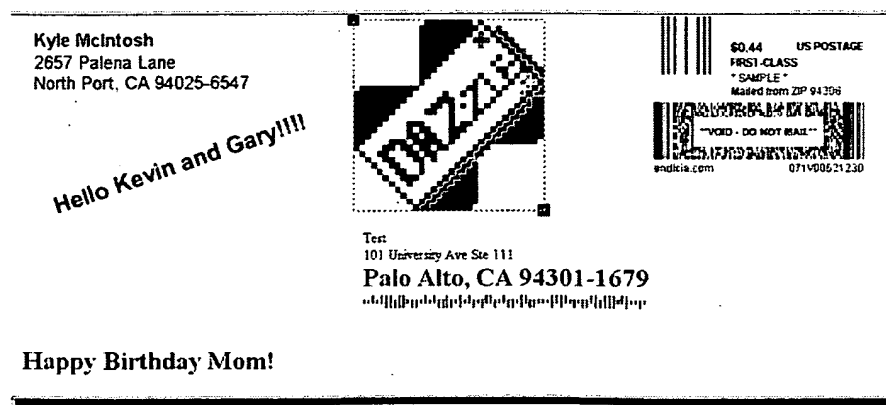
Applicants disagree with the Examiner’s assessment for at least the reason that the Examiner’s allegations are facially inconsistent due to the concession that Kovlakas does not specifically disclose generating a unique postage indicium that contains or otherwise has a logical relationship to a unique tracking identifier that can track a mail piece delivery status,

and moreover, because Kovlakas does not disclose, teach, or suggest that the "mailpiece identification data" described therein can be used "to track a mail piece delivery status within the United States Postal Service." Rather, (as essentially conceded in the rationale that the Examiner has set forth) Kovlakas describes using a *postage indicium* as the relevant indicator with which to determine whether a mail piece has entered the mailing operation stream. However, as described at length in Applicants' disclosure, the USPS processing equipment lacked two-dimensional scanning capabilities at the time that the present application and Kovlakas were filed, but the USPS scans one-dimensional barcodes corresponding to unique tracking identifiers to a substantial (i.e., close to 100%) reliability. Accordingly, Applicants' disclosure and claimed invention recites features that use a *unique tracking identifier* logically linked to a postage indicium (rather than the indicium itself) to index whether a particular mail piece has entered the mail stream and subsequently been delivered.

For example, the following image shows an exemplary shipping label having a first barcode corresponding to a postage indicium at the top and a second barcode corresponding to a unique tracking identifier in the middle bottom:

<b>E</b>	\$17.40 * SAMPLE * Flat Rate Envelope, Express Mail Commercial Base Pricing	US POSTAGE Mailed from ZIP 94306
	 VOID - DO NOT MAIL - endicid.com 071V00621230	
<b>USPS EXPRESS MAIL®</b> 0007		
Dr. Harry Whitehouse, CT(850) 321-2640 Dymo-Endicid Postage 247 High St Palo Alto, CA 94301-1041 WAIVER OF SIGNATURE REQUESTED		
SHIP TO:	MS. KAREN KEY USPS DOMESTIC PRODUCTS 475 L'Enfant Plz SW Rm 5337 Washington, DC 20260-0004	
<b>USPS SIGNATURE TRACKING #</b>		
 9471 0102 0082 8187 7430 84		
<b>POSTAL USE ONLY</b>		
Date In: Mo. Day Year	Time In: <input type="checkbox"/> AM <input type="checkbox"/> PM	
Day of Delivery: <input type="checkbox"/> Next <input type="checkbox"/> Second	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	
Return Receipt <input type="checkbox"/>	COD <input type="checkbox"/>	Additional Insurance <input type="checkbox"/>

Accordingly, the claimed invention recites various features that relate to logically linking the postage indicium with the unique tracking identifier (e.g., embedding digits from the unique tracking identifier in the data payload associated with the postage indicium, although other logical linking mechanisms may be used). In other words, because the claimed invention may logically link the postage indicium and the unique tracking identifier, wherein the USPS may scan substantially all barcodes corresponding to unique tracking identifiers on mail pieces that carry such barcodes, the claimed invention may validate whether or not the postage indicium was used by proxy (i.e., via determining whether or not the barcode corresponding to the unique tracking identifier linked to the postage indicium was scanned, which may indicate whether the postage indicium logically linked thereto was used or remains unused). However, because the USPS cannot scan barcodes that correspond to postage indicia with the same frequency or reliability that barcodes corresponding to unique tracking identifiers are scanned or share information that relate to whether barcodes that correspond to postage indicia were scanned with postage vendors, any refund protocol or methodology based on postage indicia scans (or the lack thereof) would not have the reliability provided via the features recited in the claimed invention, which uses mail piece tracking data that the USPS obtains from scanning substantially every barcode corresponding to a unique tracking identifier and that the USPS does make public on every mail piece or package carrying such barcodes. Applicants further note that letters have similar distinctions between tracking barcodes (i.e., Intelligent Mail Barcodes) that the USPS scans on substantially all letter mail and postage indicia barcodes that the USPS scans with less frequency, as shown on the following exemplary letter envelope:



On the other hand, to the extent that Kovlakas describes a system that can reconcile information that uniquely identifies a mail piece and validate postage evidence associated therewith “against centralized or distributed remote logs of postage transactions and tracking information” to determine whether a debited postage amount associated with the mail piece can be properly refunded, Kovlakas describes reconciling the unique identification information using identification data “which is part of the unique postage indicium,” as the Examiner has conceded. However, as described in Applicants’ disclosure and clarified above, postage indicia that evidence purchased postage are distinct from unique tracking identifiers that the USPS tracks to indicate whether a mail piece has entered the mail stream and subsequently been delivered. Furthermore, in ¶ [0007], Kovlakas describes querying the centralized or distributed remote postage transaction and tracking logs to determine (at best) “if the mail piece has already been *entered into the postal mailstream*,” whereas independent claim 1 recites, among other things, “refunding the postage purchase transaction based on the mail piece *delivery status* associated with the unique tracking identifier.” Clearly, whether a mail piece has entered the postal mailstream raises a different question from whether the mail piece has been delivered following entry into the postal mailstream, and the Examiner has consistently failed to properly consider and reconcile this difference. See, e.g., Applicants’ disclosure at page 69, line 19 - page 70, line 4 (describing the misleading nature of a status indicating that “Your item was accepted at 10 pm on August 21 in Palo Alto, CA 94301,” which infers that the USPS actually took possession of this package but in “reality [] only indicates the date/time in which the tracking information was posted to the master tracking computer system.”).

Accordingly, the claimed invention recites various features that use the “delivery status” associated with the unique tracking identifier to obviate these potential discrepancies because the package “will never achieve a status of ‘delivered’” if the user never mailed a package with the tracking identifier (Applicants’ disclosure, pages 67-68, Table 3 and page 68, lines 2-8). In other words, although a mailer, personal computer meter, and date and time associated with a postage indicium may be suitable to uniquely identify a particular mail piece, that information does not provide an ability “to track a mail piece delivery status” associated therewith. Applicants’ disclosure describes in substantial detail how unique tracking identifiers

that provide such a capability have distinct characteristics from postage indicia, whereby using unique tracking identifiers to validate refund inquiries may address many issues that would arise in a system that only uses postage indicia information to process refund inquiries. As such, because Kovlakas does not disclose, teach, or suggest the "mailpiece identification data" described therein being used "to track a mail piece *delivery status* within the United States Postal Service," the Examiner has improperly equated one with the other. For at least these reasons, Kovlakas fails to disclose, teach, or suggest the aforementioned features recited in amended independent claim 1, for example.

Williams fails to cure the foregoing deficiencies of Kovlakas. In particular, although the Examiner has conceded that Kovlakas does not specifically disclose generating a unique postage indicium that contains or otherwise has a logical relationship to a unique tracking identifier that can track a mail piece delivery status, the Examiner alleges that Williams discloses a postal return system that can be used to create a system tracking number linked to a postage tracking table to determine the specific tracking state associated with a package, which the Examiner alleges to cure the conceded deficiencies of Kovlakas. Applicants disagree with the Examiner's assessment for at least the reason that to the extent that the Examiner correctly alleges that Williams describes a postal return system, Williams indicates that the postal return system described therein may be used to print a shipping label to return goods (e.g., apparel, lawn and garden equipment, etc.) rather than receive refunds on purchased postage. The Examiner has previously cited references inapposite to the claimed invention in the exact same respect (e.g., U.S. Patent No. 6,547,136 to Sansone), which Applicants have already distinguished on the grounds that providing free postage to ship a package returning goods cannot reasonably be characterized as receiving a refund for a postage purchase transaction because shipper did not even purchase the postage. Moreover, to the extent that the system tracking number described in Williams may be used to determine the tracking state associated with a package, Williams does not disclose, teach, or suggest using the system tracking number or the associated tracking state to index a postage purchase transaction or control whether or not to refund a postage purchase transaction. In fact, Williams does not

appear to have any relevance to refunds associated with postage purchases. As such, for at least these reasons, Williams fails to cure the foregoing deficiencies of Kovlakas.

Accordingly, for at least the foregoing reasons, Kovlakas and Williams, either alone or in combination, fail to disclose, teach, or suggest each and every feature recited in amended independent claim 1. Claims 4-6, 8-9, and 12-13 depend from and add features to amended independent claim 1. The rejection is therefore improper and must be withdrawn.

**D. CLAIMS 3, 14-24, 26-28, 33-38, 40-42, 48, AND 55-56**

As noted above, the Examiner has rejected claim 3 under 35 U.S.C. § 103 as allegedly being unpatentable over Kovlakas in view of Williams and Lewis, claim 14 as allegedly being unpatentable over Kovlakas in view of Williams and Whitehouse, claims 15, 17-18, 21-24, 26-27, 29-35, 38, 42, 44-45, 48, and 55-56 as allegedly being unpatentable over Kovlakas in view of Williams, Whitehouse, and Gordon, and claims 16, 19-20, 28, 36-37, and 40-41 as allegedly being unpatentable over Kovlakas in view of Williams, Whitehouse, Gordon, and Lewis. These rejections are improper and must be withdrawn for at least the reason that the references relied upon, either alone or in combination, fail to disclose, teach, or suggest each and every feature recited in the claimed invention.

More particularly, for at least the reasons discussed above, Kovlakas and Williams, either alone or in combination, fail to disclose, teach, or suggest “generating . . . a unique postage indicium in response to receiving a request for a postage purchase transaction, wherein the unique postage indicium is logically linked to a unique tracking identifier to track a mail piece delivery status within the United States Postal Service,” “indexing the postage purchase transaction with the unique tracking identifier logically linked to the unique postage indicium in a database [that] associates the indexed postage purchase transaction with the mail piece delivery status associated with the unique tracking identifier logically linked to the unique postage indicium,” and “refunding the postage purchase transaction based on the mail piece delivery status associated with the unique tracking identifier logically linked to the unique postage indicium,” as recited in amended independent claim 1, for example.



Amended independent claims 15, 23, 28, 33, and 48 include features similar to those set forth in amended independent claim 1, whereby Kovlakas and Williams, either alone or in combination, fail to disclose, teach, or suggest each and every feature recited in amended independent claims 15, 23, 28, 33, and 48 for at least the same reasons.

Lewis fails to cure the foregoing deficiencies of Kovlakas and Williams because, to the extent that Lewis generally describes a system that can process postage refund requests (e.g., col. 13, Table II), Lewis does not disclose, teach, or suggest any details that relate to conditions that control whether or not to grant the refund requests, much less conditioning whether or not the refund requests can be granted on a "mail piece delivery status associated with [a] unique tracking identifier logically linked to [a] unique postage indicium," wherein the unique tracking identifier indexes a postage purchase transaction in which the unique postage indicium was generated and for which the refund was requested. As such, for at least these reasons, Lewis fails to cure the foregoing deficiencies of Kovlakas and Williams.

Whitehouse fails to cure the foregoing deficiencies of Kovlakas, Williams, and Lewis because Whitehouse does not describe refunding postage purchase transactions based on a "mail piece delivery status associated with a unique tracking identifier" that indexes a postage purchase transaction in which a unique postage indicium logically linked to the unique tracking identifier was generated and for which the refund was requested. Rather, Whitehouse generally describes a system that may refund purchased postage if the USPS has not processed "an indicium with the date, meter number and serial number of the allegedly misprinted indicium" (col. 24, line 53 *et seq.*). However, in contrast to the techniques that Whitehouse describes to refund postage purchase transactions based on the status associated with a **postage indicium**, the claimed invention distinctly recites a "unique postage indicium" and a "unique tracking identifier" logically linked thereto, wherein the latter may index a postage purchase transaction in which the postage indicium was generated such that the delivery status associated with the "unique tracking identifier" can be referenced to determine whether or not the postage purchase transaction in which the postage indicium was generated may be properly refunded. As such, for at least the reason that Whitehouse does not describe determining whether or not refund a postage purchase transaction based on a mail piece

delivery status associated with a unique tracking identifier, Whitehouse fails to cure the foregoing deficiencies of Kovlakas, Williams, and Lewis.

Gordon fails to cure the foregoing deficiencies of Kovlakas, Williams, and Whitehouse because the Examiner has only alleged that Gordon discloses identifying or detecting counterfeit indicia if multiple identical indicia are identified in a comparison between information stored in a master log database and information scanned from a mail piece and utilizing a serial or transaction number associated with a postage indicium to index the master log database. However, as discussed in further detail above, the claimed invention recites a "unique postage indicium" distinctly from a "unique tracking identifier," whereby the "**unique tracking identifier**" indexes the postage purchase transaction in which the postage indicium was generated (rather than the postage indicium itself), and moreover, the delivery status associated with the "**unique tracking identifier**," among other information associated with the postage purchase transaction indexed therewith, can be referenced to determine whether or not to refund the transaction in which the postage indicium was generated. As such, for at least the reason that utilizing information associated with a postage indicium to index a postage purchase transaction does not disclose, teach, or suggest indexing a postage purchase transaction with "a unique tracking identifier" logically linked to the postage indicium, Gordon fails to cure the foregoing deficiencies of Kovlakas, Williams, and Whitehouse.

Accordingly, for at least the foregoing reasons, the references relied upon, either alone or in combination, fail to disclose, teach, or suggest each and every feature recited in amended independent claims 1, 15, 23, 28, 33, and 48. Claims 3, 14, 16-22, 24, 26-27, 34-38, 40-42, and 55-56 depend from and add features to amended independent claims 1, 15, 23, 28, 33, and 48. Thus, the rejections are improper and must be withdrawn for at least the foregoing reasons.

## CONCLUSION

Having addressed each of the foregoing rejections, Applicants respectfully submit that a full and complete response has been made to the outstanding Office Action. As such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: December 5, 2011

Respectfully submitted,

By:



Syed Jafar Ali

Registration No. 58,780

**PILLSBURY WINTHROP SHAW PITTMAN LLP**  
P.O. Box 10500  
McLean, Virginia 22102  
Main: 703-770-7900  
Direct: 703-770-7540  
Fax: 703-770-7901